PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT
DESIGNATING THE U.S. ABANDONED UNAVOIDABLY UNDER 37 CFR 1.137(a)Docket Number (Optional)
0152800342100

First named inventor: KASLOW

U.S. Application No.: 09/554,960
(if known)

International (PCT) Application Number: PCT/US98/25742

Filed: May 22, 2000

Title: VACCINES FOR BLOCKING TRANSMISSION OF PLASMODIUM VIVAX

Attention: PCT Legal Staff
Box PCT
Assistant Commissioner for Patents
Washington, D.C. 20231RECEIVED
14 JAN 2002
Lynn Staff
International Division

The above-identified application became abandoned as to the United States because the fees and documents required by 35 U.S.C. 371(c) were not filed prior to the expiration of the time set in 37 CFR 1.494(b) or (c) or 1.495(b) or (c) (as applicable). The date of abandonment is the day after the date on which the 35 U.S.C. 371(c) requirements were due. See 37 CFR 1.494(g) or 1.495(h).

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Proper Reply;
- (3) Terminal disclaimer with disclaimer fee -- required for all international applications having an international filing date before June 8, 1995, and
- (4) Adequate showing of the cause of unavoidable delay

1. Petition fee

- ☐ small entity - fee \$ _____ (37 CFR 1.17(l)). Applicant claims small entity status. See 37 CFR 1.27.
- ☒ other than small entity - fee \$ 110 (37 CFR 1.17(l)).

2. Proper Reply

- A. The proper reply (the missing 35 U.S.C. 371 (c) requirements) in the form of a Continued Prosecution Application (identify the type of reply):

- ☐ was previously filed on _____.
- ☒ is enclosed herewith.

[Page 1 of 3]

Burden Hour Statement: This form is estimated to take 1.0 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

BEST AVAILABLE COPY

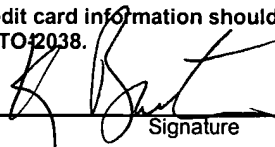
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number

**PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT DESIGNATING THE U.S.
ABANDONED UNAVOIDABLY UNDER 37 CFR 1.137(a)**

3. Terminal disclaimer with disclaimer fee



Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.

A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$ _____ for a small entity
or \$ _____ for other than a small entity) disclaiming the required period of time is
enclosed herewith (see PTO/SB/63).4. An adequate showing of the cause of the delay, and that the entire delay in filing the 35 U.S.C. 371(c)
requirements (or a continuing US application) from their due date until the filing of a grantable petition
under 37 CFR 1.137(a) was unavoidable, is enclosed.**WARNING: Information on this form may become public. Credit card information should not be included on this
form. Provide credit card information and authorization on PTO-2038.**Date October 8, 2001Telephone Number: (415) 576-0200
SignatureKevin L. Bastian
Typed or printed nameTownsend and Townsend and Crew
Two Embarcadero Center, 8th Floor
San Francisco, California 94111
AddressEnclosures: ☒ Additional sheets containing statements establishing unavoidable delay☒ Fee Payment☒ Reply☐ Terminal Disclaimer Form☒ Continued Prosecution Application

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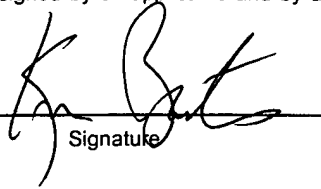
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**PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT DESIGNATING THE U.S.
ABANDONED UNAVOIDABLY UNDER 37 CFR 1.137(a)**

NOTE: The following showing of the cause of unavoidable delay must be signed by all applicants and by any other party who is presenting statements concerning the cause of delay.

October 8, 2001

Date


Signature

Kevin L. Bastian

Typed or printed name

(In the space provided below, please explain in detail why the 35 U.S.C. 371(c) elements (or continuing US application) were not timely filed.)

Applicant petitions to revive the above-identified application under 37 CFR §1.137(a). The application was unavoidably abandoned for failure to respond to a Notification of Missing Requirements mailed June 23, 2000, for the above-referenced application. Applicants, however, have no record of having received the Notice. Because the Notification of Missing Requirements was not received, no date for response was docketed and a date for abandonment for failure to respond was not set.

The entire delay, including the delay from the date of discovery of the abandonment of the application through the date of this Petition, was unavoidable.

A proposed response in the form of a Continued Prosecution Application are forwarded with this Petition.

Please deduct the petition fee, pursuant to 37 CFR §1.17(l), of \$110 from the Deposit Account No. 20-1430 of the undersigned. Please charge any additional fees or credit overpayment to the above Deposit Account. This Petition is submitted in duplicate.

PTO/PCT Rec'd 09 OCT 2001

Express Mail Label No. EL827033106US

PATENT

Atty. Docket No.: 015280-342100US



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

KASLOW

US Application No.: 09/554,960

International Application No. PCT/US98/25742

Filed: May 22, 2000

For: VACCINES FOR BLOCKING TRANSMISSION OF
PLASMODIUM VIVAX

Examiner: Unassigned

Art Unit:

**PETITION TO WITHDRAW
HOLDING OF ABANDONMENT
UNDER M.P.E.P. §711.03(c) II
BASED ON FAILURE TO
RECEIVE OFFICE ACTION**

Attention: PCT Legal Staff
Box PCT
Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicants respectfully petition that the holding of abandonment for the above-referenced patent application be withdrawn under M.P.E.P. § 711.03(c)II. In support of this petition, we provide the following:

The reply to the Notice of Missing Requirements mailed on June 23, 2000, is filed herewith in the form of a Continued Prosecution Application. As noted below, Applicants did not receive the original mailed Notice.

Please charge \$110.00, (the petition fee set forth in 37 C.F.R. §1.17(l)) to the undersigned's Deposit Account No. 20-1430. Please charge any additional fees or credit overpayment to the above deposit account. This petition is submitted in duplicate.

Facts showing that the entire delay in filing the required reply was unavoidable, from the due date for the reply until the filing of the present petition, are set forth below and substantiated by an attached Declaration Under 37 C.F.R. §1.68 of Michele Simone.

As the present application was filed after June 8, 1995, Applicants note that no Terminal Disclaimer is required under 37 C.F.R. § 137(a)(4) and (c).

The subject application was sent to the U.S. Patent Office and Trademark Office on May 22, 2000. As far as we are aware, no Notice of Missing Parts was received. The next correspondence from the United States Patent and Trademark Office in connection with this application was a Notice of Abandonment Under 37 C.F.R. §1.53(f) or (g) indicating that the application had become abandoned for failure to timely, or properly, reply to a Notice of Missing Requirements. The Notice of Abandonment stated that the Notice of Missing Requirements had been mailed on June 23, 2000.

After receipt of the Notice of Abandonment, we diligently examined our corresponding file and docket records to determine if the Notice of Missing Requirements had been received by us. Such a notice was not found in the corresponding file, and our docket records do not reflect receipt of such a notice. Please refer to the attached Declaration Under 37 C.F.R. §1.68 of Michele Simone, a docketing clerk in our U.S. docket department. Ms. Simone has been a docketing clerk in our U.S. docket department for 16 years. As mentioned in her declaration, there is no record of our U.S. docket department ever having received the Notice of Missing Requirements for this application. Accordingly, as far as we are aware, such a Notice of Missing Requirements was never received by us.

Attached to Ms. Simone's declaration, is a relevant page of Townsend and Townsend and Crew LLP's "Patent and Trademark Chronological Docket." Since the docket includes other clients' matters, information specific to those matters has been redacted to preserve confidentiality. Relevant page 447 of the docket is enclosed. The client file numbers are listed numerically. A docket date corresponding to the Notice of Missing Requirements would have appeared on page 447 (where indicated by an arrow) had there been a pending due date known to us, since the docket report is sorted by due date and then by client file number.

Since a Notice of Missing Requirements was apparently never received, Applicants were unable to file a timely response. As the delay in responding to the Notice to File Missing Parts was unavoidable, we hereby petition the Assistant Commissioner for Patents to withdraw the holding of abandonment, in view of *Delgar v. Schuyler*, 172 USPQ 513 (DDC 1971), MPEP §711.03(c)II, and 1156 OG 53, Nov. 16, 1993, copies of which are enclosed for ease of reference. The *Delgar* case suggests that in appropriate cases, the

KASLOW

PATENT

Application No. 09/554,960

International Application No. PCT/US98/25742

Page 3

Assistant Commissioner of Patents may authorize the Examiner to withdraw a holding of abandonment.

Please charge Deposit Account No. 20-1430 for appropriate additional fees pursuant to this petition.

Respectfully submitted,



Kevin L. Bastian

Reg. No. 34,774

Client No. 20350

TOWNSEND and TOWNSEND and CREW LLP

(415) 576-0200 / Fax: (415) 576-0300

KLB/jrc

SF 1277373 v1

PTO Rec'd 09 OCT 2001

Atty. Docket No. 015280-342100US



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:

KASLOW

US Application No.: 09/554,960
International Application No. PCT/US98/25742

Filed: May 22, 2000

For: VACCINES FOR BLOCKING
TRANSMISSION OF PLASMODIUM VIVAX

Examiner: Unassigned

Art Unit:

DECLARATION
UNDER 37 C.F.R. §1.68
OF MICHELE SIMONE

Attention: PCT Legal Staff
Box PCT
Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

I, MICHELE SIMONE, declare as follows:

1. I am a docketing clerk with the U.S. Docket Department at Townsend and Townsend and Crew LLP (TTC), San Francisco, California. I have been a docketing clerk at TTC since 1990.

2. I am responsible for handling incoming mail, including Office Actions, from the United States Patent and Trademark Office (USPTO). Under standard TTC operating procedures, Office Actions received from the USPTO are entered in TTC's "Patent and Mark Docket Chronological" by their due date(s). Accordingly, if a Notice to File Missing Parts of Application was mailed June 23, 2000, and had been received by TTC, it would have been entered with a due date of August 23, 2000.

3. I have reviewed the docket entries for items due August 23, 2000, and found none corresponding to the subject application.

4. Attached is an excerpt of the relevant part of the Docket identifying entries having a due date of August 23, 2000.

5. The client names, and application numbers have been redacted to preserve client confidentiality.

6. The docket entry for the subject missing Notice to File Missing Parts of Application would have been listed on page 442, given that matters for a given date are ordered by client number and matter number. This page shows client numbers to confirm that this matter would have been on this page. No such entry is listed.

7. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statement were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Dated: October 5, 2001



Michele Simone

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, 8th Floor
San Francisco, California 94111-3834
(415) 576-0200 / Fax: (415) 576-0300

Date: 07/28/00
Time: 08:18:39

DUE DATE LIST: FROM 08/01/00 TO 08/31/00
U.S. Cases Only

Page: 447

ATTY	DUE DATE	ACTION DUE/ ACTION TYPE	CLIENT FILE NO. CLASS (ES)	COUNTRY	STATUS/ NUMBER/ DATE	P/M
JGS	08/23/00	STATUS USP-STATUS	015258 040200US		PENDING	P
GWC TLS	08/23/00	2 MO EXT USP-RESPONSE	015280 295200US		PENDING	P
GWC ASP	08/23/00	1 MO UNTIL DUE USP-NON PROV	015280 405000US		PENDING	P
GWC ASP	08/23/00	1 MONTH TO FILE US-FOREIGN FILE	015280 405000US		PENDING	P
GWC ELW LJH	08/23/00	6 MO UNTIL DUE USP-NON PROV	015280 419000US		PENDING	P
KBD J3M	08/23/00	3 MO EXT/ABAND USP-RESPONSE (Final)	015325 001600US		PENDING	P

District Court, District of Columbia

DELGAR INC. et al. v. SCHUYLER,
Comr. Pats.No. 1904-70 Decided Dec. 22, 1970,
and Jan. 4, 1971

PATENTS

1. Abandonment — Application (§10.3)

Fees — Patent Office (§37.7)

Pleading and practice in Patent Office — In general (§54.1)

Although Patent Office records show that notice of allowance was mailed on a certain date to applicant's attorney, and although fee was not paid as required by 35 U.S.C. 151, court grants summary judgment authorizing Office to issue a new notice of allowance inasmuch as attorney allegedly did not receive first notice.

Action by Delgar Inc., Robert Gardel, and Egon Gorsky against William E. Schuyler, Jr., Commissioner of Patents. Summary judgment for plaintiffs.

GEORGE R. DOUGLAS, JR., and MISEGADES & DOUGLAS, both of Washington, D. C., and NOLTE & NOLTE, A. C. NOLTE, JR., EDWARD B. HUNTER, and EVELYN M. SOMMER, all of New York, N. Y., for plaintiffs.

S. WM. COCHRAN and J. F. NAKAMURA for defendant.

PRATT, District Judge.

Mr. Nakamura: If the Court please, this case is a patent case. It involves Section 151 of the Patent Statute. Section 151 provides that a written notice of allowance shall be mailed to the applicant.

This notice of allowance calls for payment of an issue fee. If that issue fee is not paid within six months, the application is regarded as irrevocably abandoned by operation of the statute.

Now, in the present case, the record shows that such a notice of allowance was mailed. The issue fee was not paid within the six months.

The application, therefore, in the eyes of the Patent Office, stands abandoned by operation of the statute.

Now, plaintiffs' claim for relief is based solely on their allegation that no notice of allowance was received by their attorneys.

We submit that the statute provides no basis for relief.

First of all, Section 151 does not expressly require that a notice of allowance be received by the applicant. In Section 151 there appears only the term "mail a written notice" —

The Court: Is there any provision for publication of allowances?

Mr. Nakamura: No, Your Honor, there is not.

The Court: Are they customarily published?

Mr. Nakamura: No, they are not customarily published. The notice is mailed. In the great majority of the cases, it is received. Occasionally it is not, for one reason or the other.

In this case the applicant has only alleged that it has not been received.

Now, there is a long-standing construction of the term "mail" in the Patent Office. This is a construction which excludes receipt. This is a construction which dates back at least 50 years, and long prior to the enactment of Section 151, which was enacted in 1965.

I can show Your Honor representative decisions that have been handed down by past Commissioners, Ex parte Lacey, for example, in 1920 C.D. 83, and Ex parte Glake in 1906 C.D. 159.

The Court: I take it that in this case there was a petition filed with the Commissioner?

Mr. Nakamura: That is correct, Your Honor.

If Your Honor would care to see the wording of Section 151, I have a copy of that statute here, which I am prepared to hand up.

The Court: It says that they provide for a sum constituting the issue fee, or a portion thereof, which shall be paid within three months thereafter. Upon payment of this sum, the patent shall issue. If payment is not timely made, the application shall be regarded as abandoned.

Mr. Nakamura: That is correct.

The Court: Then it says that any remaining balance of the issue fee shall be paid within three months from the sending of a notice thereof.

Is that the notice of allowance?

Mr. Nakamura: The first one is the notice of allowance. It contains an estimated issue fee.

The Court: The second notice that they are talking about is the notice that more money is due, I take it?

Mr. Nakamura: That is correct; if the printing exceeded the estimate.

The Court: Yes.

The Court: Has this type of situation ever been litigated before in court?

Mr. Nakamura: To my knowledge, Your

Honor, it has not. This is the first time that the question has arisen.

The Court: Now, what you have just shown me is the statute, itself, is that correct?

Mr. Nakamura: This is the statute, itself, that is correct, Your Honor.

The Court: All right, I will hear further from you, if you like.

Mr. Nakamura: Your Honor, we submit that under normal rules of statutory construction, there being no legislative intent to include receipt in the term "mailing," that the defendant has no authority to read the term into the statute in the light of the past construction of "mail" in the situation with which we are now concerned.

The Court: What is involved in resurrecting a patent which has been put in an abandoned category? Do you have to file all over again?

Mr. Nakamura: Yes. If the applicant is willing to forego the benefit of having the earlier date, the date of his earliest application, then he can file at any time.

As in this particular case, if he filed today, the application would date from today.

The Court: What does this patent cover?

Mr. Nakamura: This is a patent on a doll, Your Honor. I believe, Your Honor, before I leave, I would like to point out that there is a drawing which accompanies the patent application. It is in the file. It is a part of Exhibit A, accompanying the defendant's motion to dismiss.

The Court: Did you file a response to the motion to dismiss?

Mrs. Sommer: Yes, we did, Your Honor. We filed an opposition to the motion to dismiss.

First, I would like to sort of point out the sequence that this case went through in the Patent Office, mostly because I think that it is very interesting.

The application was filed in December, 1965, and went through a normal course of prosecution up to the filing of notice of appeal and a brief upon appeal.

Sometime in October, specifically October 9, 1968, the examiner who was prosecuting the application called a Mr. W. S. Seward, who was a partner in Nolte & Nolte, and who was the attorney who was handling the application, and advised him that he was going to allow the case. That was October 9, 1968.

On October 10, 1968, the Patent Office sent out a paper, which is Paper 14 in this case, in which the Patent Office indicated that the prosecution in the case was closed and that a notice of allowance would shortly be forwarded. This is an official form of the Patent Office.

That form, which is Form P.O.L. 255, as I said, was mailed 10/10/68, and was addressed to Nolte and Nolte.

On that very same day another paper went out from the Patent Office, which was mailed to another address. It was mailed to the firm of Brown & Seward at 11 Park Road, New York City. That very day, two papers were mailed from the Patent Office: One, the form P.O.L. 255; the other, a Form 19. Both going to different addresses.

Thereafter, another paper was mailed from the Patent Office, this being Paper Number 15 and Form P.O.L. 37. This paper carries the date January 29, 1969, and this form is what is known as a Notice of Examiner's Amendment.

This form says pretty much the same thing. It indicates some amendments that the examiner is entering pursuant to a conference had with Mr. Seward on 10/10/68, and says a notice of allowance will be forthcoming.

I think that this paper, which was addressed to Nolte and Nolte at 330 Madison Avenue, is interesting, because it carries not only the notation that the paper was typed on 10/31/68, but it was mailed on January 29, 1969.

I would like to point out that I mentioned that one paper was mailed to another address in this period. Two additional papers were mailed to Brown and Seward at 11 Park Road.

The Court: Who was the attorney for the applicant?

Mrs. Sommer: Originally, attorneys of record were Brown and Seward. During the prosecution, an associate power of attorney was filed, making Nolte and Nolte the attorneys of record.

I would like to point out, for example, that when notice of appeal was filed in this case, the notice of appeal carries an express written—typed notice which says:

All correspondence is to be addressed to Nolte and Nolte, 330 Madison Avenue.

The very next paper which was mailed by the Patent Office, which is what we call the appeal receipt, that gives the appeal number and which was mailed within about a week of that date, is mailed to Brown and Seward at 11 Park Road.

Despite the fact that the notice of appeal carries the express note: All correspondence to go to Nolte and Nolte, the appeal receipt was mailed to Brown.

So, we have a course of conduct throughout of the Patent Office's sending correspondence to different addresses.

Fortunately, the mail was rerouted by the Patent Office and the papers that I am refer-

ring to were received by Nolte at 330 Madison Avenue.

I also want to mention that the Patent Office made notices of allowance which they carry the name of the applicant, and mailed out. It is typed out on the next day, which is Form 255, which is typed on the next day, January 29, 1969, months later, than the notice of allowance.

Mr. Nakamura: The notice of allowance, mentioned in the statute, 35 U.S.C. 151, and that allowance be made. Specifically, given.

I have a question about the patent law, the applicant, a writer, the application shall be filed.

In other words, a little bit more box. It cannot be mailed. In other words, the statute.

Furthermore, the statute of allowance is different than the other construction rule—yes. It is from the statute, and it is not. If upon examination, the applicant is allowed, a notice of allowance is issued.

If the word "allowance" is in the papers—it indicates that the application is allowed.

Also, in the case of Mr. Nakamura.

We would like to see the court, the 1st Circuit, the 4th Circuit, the 5th Circuit, the 6th Circuit, the 7th Circuit, the 8th Circuit, the 9th Circuit, the 10th Circuit, the 11th Circuit, the 12th Circuit, the 13th Circuit, the 14th Circuit, the 15th Circuit, the 16th Circuit, the 17th Circuit, the 18th Circuit, the 19th Circuit, the 20th Circuit, the 21st Circuit, the 22nd Circuit, the 23rd Circuit, the 24th Circuit, the 25th Circuit, the 26th Circuit, the 27th Circuit, the 28th Circuit, the 29th Circuit, the 30th Circuit, the 31st Circuit, the 32nd Circuit, the 33rd Circuit, the 34th Circuit, the 35th Circuit, the 36th Circuit, the 37th Circuit, the 38th Circuit, the 39th Circuit, the 40th Circuit, the 41st Circuit, the 42nd Circuit, the 43rd Circuit, the 44th Circuit, the 45th Circuit, the 46th Circuit, the 47th Circuit, the 48th Circuit, the 49th Circuit, the 50th Circuit, the 51st Circuit, the 52nd Circuit, the 53rd Circuit, the 54th Circuit, the 55th Circuit, the 56th Circuit, the 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ring to were received in the Office of Nolte and Nolte at 330 Madison Avenue.

I also want to point out—because the Patent Office made a big issue of the fact that notices of allowance are typed on one day and they carry the next mailing day and they are mailed out. It is presumed that they are mailed out on the next day—that the form P.O.L. 255, which I mentioned before, carries the typing date 10/31/68 and was mailed January 29, 1969. In other words, some three months later, this was mailed out of the Patent Office.

Mr. Nakamura, counsel for the Patent Office, mentioned that the rule which is involved, or the statute which is involved, is 35 U.S.C. 151, and that this requires that the notice of allowance be mailed.

Specifically, the statute says, "Mailed or given."

I have a copy of the statute here and the patent laws. It says, "If it appears that the applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant."

In other words, I think that it connotes a little bit more than just putting it in the mailbox. It connotes that it is either given or mailed. In other words, both terms appear in the statute.

Furthermore, the Patent Office has promulgated its own rules in connection with notice of allowance. And the rule is a little different than the Patent Office and puts a stricter construction—I am sure that I have the rule—yes. The rule which is involved, and this is from the Patent Office Rules, is Rule 311, and it is noted under "Notice of Allowance: If upon examination it shall appear that the applicant is entitled to a patent under the law, a notice of allowance will be sent to him."

If the word "sent" is looked up in the dictionary—and we mentioned this in some of the papers—it indicates more than mailed. It indicates that it is going to be received.

Also, in connection with mail given or sent, Mr. Nakamura cited some cases.

We would like to point out that this very court, the District of Columbia, has, in a decision, *Creasy versus the United States*, and that is 4 F.Supp. 175, D.C.-Va. 1933, expressly set out that there is no notice unless it is received.

In other words, just merely putting it in the mail is not notice. The notice must be received.

The Court: Mrs. Sommer, did you receive the January 29th letter, that is January 29, 1969, that the application was being passed to issue by the examiner?

Mrs. Sommer: Yes, sir, we did.

The Court: What did you do when you got that?

Mrs. Sommer: We got that. I happen to have a copy of the correspondence here with me. Mr. W. S. Seward, who was a partner in the firm of Nolte and Nolte, was handed that in the course of—in other words, the mail is opened in a very specific manner. The papers are entered and a record is made of all mail that is received. If there is anything that the applicant must do—in other words, if there is anything that we have to do, the office has to do—it is entered onto the outside of a file, and on the outside of the file, the date that the thing came in and the date for response appears.

Nothing appears on this outside of this file after the fact that an appeal brief was entered. There was an amendment also entered, which also appears.

There is no indication of notice of allowance receipt, because it was never received.

The Court: Is there any indication that the January 29th letter was received?

Mrs. Sommer: No; the only indication is that we have it and have the letter written by Mr. Seward, in which he advised the client that this notice had been received. There is nothing for the applicant to do when that is received.

The Court: What is the normal time span between this kind of a communication and the receipt of the notice of allowance?

Mrs. Sommer: Well, we have cited a case in this case. The patent is *Tran Van Khai Patent*. I have the number. It is Number 3498764. An instance there was 13 days.

We have also mentioned patent applications in our own file, where it has gone up to eight months. There is no statutory requirement that we inquire.

In other words, if a normal office action is received that there has been a notice promulgated by the Patent Office which says that within two months if nothing has happened you should write a status letter.

There is no requirement with respect to this notice that a patent will be issued on inquiring.

The Court: Don't most people, when they do not get the notice of allowance, promptly get on the telephone or write a letter or do something about inquiring about where it is.

Mrs. Sommer: I would say no.

In the same file, *Tran Van Khai*, which we referred to, the same procedure arose, and it is not conventional to inquire. Not in this.

The Court: It is my experience in dealing with the Government that if you know a letter

is coming and you do not get it, you get on your horse.

Mrs. Sommer: We are now inquiring at the end of two months.

The Court: It does not matter whether it is the Patent Office, or any other branch of Government: The Federal Power Commission, the Federal Communications Commission, Internal Revenue, any of these. If you know that something is going to happen and it does not happen and you have not received it, why, I think it is par for the course to call up and say: Look, we missed something.

Mrs. Sommer: Well, I have to admit that previous to this we had—in some cases the attorney would keep a record. Then he would inquire. But it was no general rule. We now have the general rule in the office that the Docket Clerk inquires at the end of two months.

I wanted to make another point in this case: There are a number of decisions in which this same issue came up, where the notice of allowance allegedly was not received. These decisions are in no way made public. In other words, they have not been published. This Tran Van Khai Case I referred to.

Mr. Nakamura served Mr. Douglas yesterday with a paper, Opposition by Defendant to Plaintiffs' Motion for Summary Judgment, in which a noted decision is mentioned, in which, in fact, the decision appears as Exhibit C, all going to this point of late payment of final fee.

And there is another one. I have the Patent Application Number. I do not have the number of the issued patent.

None of these decisions have ever been published by the Patent Office, by the agency. There is no record of them.

We would like to point out, therefore, that these decisions can not be relied upon, whether they are positive or negative, really, by the Patent Office, since there has been no notice, as is required by the Administrative Act and by the Public Information Section of the Administrative Act, which says that, specifically 552 under 2 (a), that each agency, in accordance with published rules, shall make available for public inspection a copy (a) a final opinion; (b) those statement of policy and interpretations which have been adopted by the agency and are not published by the Federal Register, so on and so forth. None of these decisions. There is a large number of them. We have referred to three right here. We can mention three right here. One of which for the first time I saw this morning, because I saw these opposition papers this morning. Two of which were obtained for us by Mr. Douglas through personal contacts.

In other words, you would never know that the Commissioner had decided favorably, and had decided favorably in the Tran Van Khai Case, which is the exact same as the instant case; the exact same facts existant that Commissioner Reynolds decided in October 1969, I believe it was, that another notice of allowance would be forthcoming.

His decision is very simple. He says: On the facts in the case. His decision is dated October 30, 1969. It is in the file of U. S. Patent 3498764. He says: The renewed petition filed October 17, 1969, for the acceptance of a final fee in the above-entitled application has been considered. On the basis of the entire record, as now presented, it is thought proper to hold that a notice of allowance of the application was not duly mailed on November 15, 1968. Accordingly, the present action is to be treated as such a notice of allowance. Since the issue fee was paid on July 10, 1969, the patent will be issued in due course. The petition is granted to the extent indicated.

There is another one where the exact situation arose. Again Commissioner Reynolds issued the patent.

In other words, the Commissioner has, in situations which parallel this case on all fours, subsequently permitted the payment of the final fee which was due and issued a notice of allowance. The loss of a patent. I do not believe that it is germane to the issue, but we mentioned that this is a patent for a doll; specifically, it is for a walking doll, and a very important doll.

This application form has licenses all over the world.

In other words, I do not want to mention the assignee, because that gets into particulars which are not germane.

This is a very commercial patent; extremely important.

If the patent does not issue, we are now in the situation where there is really nothing under the recent decisions on know how and secret information, and so on. There is nothing left.

This patent has issued. For example, there are corresponding patents in other countries in the world. There is for sure I know in Germany. I am not sure of the other countries. As I say, it has been licensed all over the world.

The applicants have exhausted their remedy in the Patent Office and have filed petitions, renewed petitions, all of which have been denied by Assistant Commissioner Kalk on the grounds, first of all, that the statute prevents him from acting otherwise.

I just pointed out at least two cases where Assistant Commissioner Reynolds has also, as

an arm of the Patent Office.

Also, the Patent Office is putting allowance with the notice that the Patent Office

We have set out the Patent Office did a notice of allowance

Number One, it types it on the day it is in our case would it is universal procedure but types in another sent to the mail, mailed out from there is made in the mail room or of its

Any record which entered from a calendar the Notice of Issuance room.

So, we, as in 1 were sustained, we tained, do not be can rely on their s and that they have it.

I pointed out that it was typed months later, in o was typed one da was never received record of it anyway

I also want to p said that usually there are instan received; where the or misdirected, c into the wrong of

We do not fe that. We just ha received it. It was

Inquiry was connection with application in sponding applica

Mr. Seward, member, it was States—he went and saw that the Then immediate

The Court: A Mr. Nakamu would like to a here.

First of all, v in other pater referred to, an argument with Procedure Act.

an arm of the Patent Office, decided differently.

Also, the Patent Office feels that just mailing it and putting a copy of the notice of allowance with the word "mailed" on it is all that the Patent Office has to prove.

We have set out in considerable detail what the Patent Office does with respect to mailing a notice of allowance.

Number One, they send it to a typist, who types it on the day before it is dated. The typist in our case would have typed it. In all cases, it is universal procedure. Types it on one day, but types in another date. The thing is then sent to the mail room, and presumably is mailed out from the mail room. No record of it is made in the mail room; of its receipt in the mail room or of its actual mailing.

Any record which is entered into the file is entered from a card or tape which is made in the Notice of Issue Branch; not from the mail room.

So, we, as in *Tran Van Khai*, where they were sustained, where the appellant was sustained, do not believe that the Patent Office can rely on their saying that they just mailed it and that they have a record that they mailed it.

I pointed out in one case where they say that it was typed on one day and mailed three months later, in our own file. This presumably was typed one day and mailed the next day. It was never received in our office. There is no record of it anywhere.

I also want to point out that Mr. Nakamura said that usually these things are received. But there are instances where they are not received; where they are not correctly addressed, or misdirected, or who knows what, and get into the wrong office.

We do not feel that we have to establish that. We just have to prove that we never received it. It was never received in the office.

Inquiry was made at the Patent Office in connection with the prosecution of another application in another country, a corresponding application in another country.

Mr. Seward, who was handling it—I remember, it was *Louden* against the United States—he went and got the United States' file and saw that there was no notice of allowance. Then immediately the petition was filed.

The Court: Mr. Nakamura.

Mr. Nakamura: If I may, Your Honor, I would like to add some comments in rebuttal here.

First of all, with reference to these decisions in other patents which Mrs. Sommers has referred to, and with reference, also, to her argument with respect to the Administrative Procedure Act, I would like to point out this:

That these two decisions that she mentioned are in the patent files. As such, they are available to the public.

Now, it is true that we have not indexed them. But as Your Honor will appreciate from the number of cases which have come up on this point, it apparently would be a burden on the Patent Office to index such decisions.

Now, with respect to the first of those cases, the *Tran Van Khai* Case, I believe, is mentioned by Mrs. Sommer.

I would like to point out this fact, that the attorney in that case complained not only that he did not receive the notice of allowance, but he also complained that the firm was not shown correctly in the address.

So, in this case there was some possible indication that the Patent Office had not very properly mailed the notice of allowance.

The Court: Mr. Nakamura, the reason that Mr. Reynolds accepted the final fee in the *Tran Van Khai* Case was because of the fact that he was satisfied that the notice of allowance had not been received; is that not true?

Mr. Nakamura: Had not been duly mailed, Your Honor. I believe that was the comment.

The Court: He said not duly mailed?

Mr. Nakamura: Not duly mailed.

If one looks to the reasons that supported the attorney's petition—in my copy here, it would be on the 4th page, after the decision of Commissioner Reynolds; then the next to the last sentence of the petitioner says: If the Patent Office actually mailed a notice of allowance in the present case, how can it be so sure that it was mailed to the applicant's attorney, as 35 U.S.C. 151 requires, especially when it is ruled that the Patent Office copy of the notice of allowance did not even show the attorney's name correctly.

[1] The Court: In this case, your own record shows that notice of allowance was mailed on a certain date?

Mr. Nakamura: Yes, it does, Your Honor.

The Court: It shows to whom it was mailed?

Mr. Nakamura: Yes, that is correct.

The Court: To Nolte and Nolte?

Mr. Nakamura: That is correct. We have a copy in the file papers that, perhaps, Your Honor may be interested in seeing just what that notice of allowance looks like. I have the actual application file here.

The Court: What was mailed was presumably a carbon of that, I take it?

Mr. Nakamura: Yes, Your Honor; this is the original, and a carbon is mailed as a matter of practice.

There is one other point that I would like to make, Your Honor:

In our opposition, which was filed yesterday, there is attached Exhibit B, which is the last decision of the Assistant Commissioner in this particular case.

I would like the Court to note that in the last line on the first page Commissioner Kalk says: Petitioners are apparently the only ones who have complained about not receiving a notice of allowance mailed on February 20, 1969. 331 were mailed that day.

There is just one statement that I would like to make in closing, Your Honor:

There is a reason why Assistant Commissioner Reynolds allowed the petitions in the two cases that Mrs. Sommer has mentioned. There is equally a good reason why the petition in this case was denied.

The distinction is this: If there is any positive indication in the application filed, itself, that the Patent Office may have not properly mailed a notice of allowance, then the Commissioner will grant relief. But if there is no such indication, no such positive indication of improper mailing by the Patent Office of the Patent Office application, and there is only the allegation that the applicant did not receive the notice of allowance, then relief is denied.

The Court: Your proof of mailing is the possession of the ribbon copy of the notice of allowance, which is part of your file?

Mr. Nakamura: That is correct.

The Court: The fact of mailing the notice is entered some place else?

Mr. Nakamura: Yes, it is. It is on the face of the application filed. I don't know whether Your Honor noticed that. In the lower right-hand corner there is a stamped in date of February 20, 1969.

There is a block there. I believe, that is labeled "Notice of Allowance." Date mailed: February 20, 1969. That is the date that it was mailed.

The Court: Who put that on there?

Mr. Nakamura: This would be placed on there by the issuing branch.

The Court: But they have no other record other than having put that stamp on there, is that correct?

Mr. Nakamura: Other than having kept a tally of the total number which were mailed that day, or each day, there is no record kept on specific applications.

The Court: Mr. Nakamura, is there any particular pattern about when notices of allowance are issued?

Mr. Seward's affidavit has four cases cited, one of which has an allowance notice sent after 13 days; another one was a month and 20 days; another one was four months and 21 days; another one is eight months and three days.

With respect to one of these, they mention a status letter which was sent and brought no response. The second status letter brought a telephone call from the examiner, giving the date of allowance, stating that the application was abandoned for failure to file an issue fee. In that case a petition to review is pending.

Mr. Nakamura: In answer to your question, Your Honor, there is no period, I believe, that one can count on from notification to the mailing of the notice of allowance. It fluctuates. It depends upon the work load. It depends upon the people there that particular day; whether they have gotten behind. I am afraid that it is not a predictable figure.

The Court: What about the status letters and telephone calls?

Mr. Nakamura: Telephone calls would be answered. Status letters generally are answered. But I would not say that they are invariably answered. That would not be correct.

The Court: What would be the effect on the Department if the rule were other than requiring the notice to be mailed, but also require that it be received?

Mr. Nakamura: Then I believe that we would have to grant a petition in every case that comes into the Patent Office complaining about failure to receive notice of allowance.

The Court: How many of those have you had in the past?

Mr. Nakamura: There are probably not too many, but I would not say for sure. I can say this much; that—well, no, I don't think that is a very good estimate. I was going to say that in addition to the two cases that I handed up to you, there is one other published Commissioner's Decision that I know about. There are a few others, but they all date back to the 1920's or earlier.

The Court: Those are Patent Office Gazette reported cases?

Mr. Nakamura: That is correct.

The Court: What I was thinking about is in your normal experience does this happen very often? There may have been some cases in situations where this has happened, and because of these decided cases they have not taken it further; or the subject matter might not have been sufficient to warrant going further. I was just wondering, as a matter of general experience, does this happen very often?

Mr. Nakamura: I am not personally experienced in this, Your Honor. But I am quite sure that there are, from time to time, cases coming up on this point. Just from casual conversation, I know this personally.

The Court: Well, I think that I have heard enough. I am going to deny the Government's

motion to dismiss kind of relief.

I am going out the form so that it will be the patent's problem.

The reason cause it is difficult notice was of people, who apparently never came.

I am perfect language of the Patent Office Nakamura.

But I think this, that could administrative would permit commodated in the of the state.

So, I will Mr. Nakamura an order on.

The reason that is because with the important position would not further than about patent trust my own.

Mrs. Sommer

Mr. Nakamura Your Honor

Upon motion to Dismiss Summary it is by the 1970,

Ordered Dismiss the Motion for granted, authorized the plaintiffs' 380, in suit

motion to dismiss and grant the plaintiffs some kind of relief.

I am going to require the plaintiff to work out the form of the order with Mr. Nakamura, so that it will do the least damage to the Department's practice.

The reason why I am ruling as I am is because it is difficult for me to believe that the notice was or was not received, when these people, who have every interest in its receipt, apparently acted on the assumption that it never came.

I am perfectly willing to admit that the language of the statute and the decisions of the Patent Office are just as you stated, Mr. Nakamura.

But I think that in the rare case, such as this, that comes up, that, because of the fair administration of law by the Patent Office, it would permit these rare situations to be accommodated instead of relying on the strict letter of the statute.

So, I will charge you, Mrs. Sommer and Mr. Nakamura, to work it out and I will sign an order on it.

The reason that I am requiring you to do that is because of the fact that Mr. Nakamura is with the Patent Office and he has an important position down there. I am sure that he would not agree to an order that would go further than it has to. I do not know enough about patents to take the responsibility or trust my own judgment.

Mrs. Sommer: Thank you, Your Honor.

Mr. Nakamura: I believe that I understand Your Honor.

Jan. 4, 1971

ORDER

Upon consideration of the defendant's Motion to Dismiss and the plaintiffs' Motion for Summary Judgment and the hearing thereon, it is by the Court this 31st day of December 1970.

Ordered that (1) the defendant's Motion to Dismiss herewith is denied, (2) the plaintiffs' Motion for Summary Judgment herewith is granted, and (3) the defendant herewith is authorized to issue a notice of allowance in plaintiffs' patent application Serial No. 513,380, in suit.

District Court, District of Columbia

MONTECATINI EDISON, s.p.a. v. ZIEGLER et al.

Decided Jan. 25, 1972

PATENTS

1. Revised Statutes 4915 suits — In general (§59.01)

Revised Statutes 4915 suits — Issues determined (§59.05)

Action under 35 U.S.C. 146 is not a standard civil action, but is more in the nature of a review of administrative proceeding with inherent limitations on issues which may be raised in original claim or by counterclaim; thus, defendant may not raise by counterclaim for the first time issues such as tortious conduct and breach of contract which involve numerous other patents and pending applications; actions under section 146 are limited to review of administrative proceeding in Patent Office supplemented by additional evidence and testimony only insofar as it relates to contentions advanced below.

2. Counterclaim — Compulsory or permissive (§26.3)

In action under 35 U.S.C. 146, counterclaim is not compulsory where it alleges tortious acts, frauds, and breaches of contract involving various patents, patent applications, and confidential information, even if there may be a commonality of proof between that needed to establish priority of invention and that needed to establish a portion of allegations of counterclaim, since commonality required to make counterclaim compulsory is that found in a logical relation in the events from which claim and counterclaim arise, not in fact that counterclaim has as one of its facets an issue or subject which is same as that involved in claim.

Action under 35 U.S.C. 146 by Montecatini Edison, s.p.a., against Karl Ziegler and E. I. du Pont de Nemours & Co. in which Karl Ziegler counterclaims for breach of contract and damages. On plaintiff's motion to dismiss counterclaim. Motion granted.

MORGAN, FINNEGAN, DURHAM & PINE (RALPH M. WATSON of counsel) both of New York, N. Y., for plaintiff.

BURGESS, DINKLAGE & SPRUNG (ARNOLD SPRUNG of counsel) both of New York, N. Y., for Karl Ziegler.

Erratum

"All references to Patent No. 5,254,810 to Friedrich Schauer, et. al. of Germany for 'DEVICE FOR TRANSFERRING CURRENT BETWEEN TWO END POSITIONS WHICH ARE MOVABLE RELATIVE TO EACH OTHER' appearing in the *Official Gazette* of October 19, 1993 should be deleted since no patent was granted."

Registration to Practice

The following person successfully passed the registration examination that was held October 14, 1992. Final approval for registration is subject to establishing to the satisfaction of the Director of the Office of Enrollment and Discipline that the person seeking registration is of good moral character and repute. [37 CFR 10.7(a)]. Accordingly, any information tending to affect the eligibility of the following applicant on moral, ethical, or other grounds should be furnished to the Director, Office of Enrollment and Discipline on or before (45 days after the date this notice is published).

Gualtieri, Gina M., 408 N. 32nd St., Unit 3, Philadelphia, PA

Oct. 21, 1993

CAMERON WEIFFENBACH

*Director
Office of Enrollment Discipline*

Registration To Practice

The following list contains the names of persons applying for registration to practice before the United States Patent and Trademark Office. Final approval for registration is subject to establishing to the satisfaction of the Director of the Office of Enrollment and Discipline that the person seeking registration is of good moral character and repute. [37CFR 10.7(a)]. Accordingly, any information tending to affect the eligibility of any of the following applicants on moral, ethical, or other grounds should be furnished to the Director, Office of Enrollment and Discipline on or before (45 days after the date this notice is published).

Elmore, Carolyn S., 13 Alexandria Dr., Oxon Hill, MD 20745
Friedman, Stanley J., 3900 Charles Ave., Alexandria, VA 22305
Sever, Frank, Jr., 4924 Hine Dr., Shady Side, MD 20764
Stahl, Robert F., Sr., 3011 Largo Rd., Upper Marlboro, MD 20772

Oct. 21, 1993

CAMERON WEIFFENBACH

*Director
Office of Enrollment Discipline*

Withdrawing the Holding of Abandonment
When Office Actions Are Not Received

The purpose of this notice is to announce a practice that will minimize costs and burdens to the practitioner and the Office when an application has become abandoned due to a failure to receive an Office action.

A petition to withdraw the holding of abandonment in accordance with *Delgar Inc. v. Schuyler*, 172 USPQ 513 (D.D.C. 1971) is burdensome to the practitioner since the practitioner must overcome a strong presumption that an Office action duly addressed and indicated as mailed was timely delivered to the addressee. To overcome this presumption, a practitioner is currently required to submit a persuasive showing that would permit the Office to conclude that the Office action was not received. Accordingly, evidence which is typically required includes: copies of records which would disclose the receipt of other correspondence mailed from the Patent and Trademark Office on or about the mail date of the non-received Office action, but fail to disclose receipt of the Office action mailed that date; copies of records on which the Office action would have been

entered had it been received (e.g., a copy of the outside of the file jacket maintained by the practitioner); and verified statements from persons who would have handled the Office action (e.g., mail clerks, docket clerks, secretary, etc.).

In order to minimize costs and burdens to the practitioner and the Office when an application has become abandoned due to a failure to receive an Office action, the Office is modifying the showing required to make a petition to withdraw the holding of abandonment grantable. The showing required to establish the failure to receive an Office action must consist of a statement from the practitioner stating that the Office action was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office action was not received. A copy of the docket record where the non-received Office action would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement.

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail, e.g., if the practitioner has a history of not receiving Office actions. Two additional procedures are available for reviving an application that has become abandoned due to a failure to respond to an Office Action: (1) a petition based on unintentional abandonment or delay; and (2) a petition based on unavoidable delay. See Manual of Patent Examining Procedure §711.03(c).

Oct. 25, 1993

Charles E. Van Horn
*Patent Policy and Projects Administrator
Office of the Assistant Commissioner
for Patents*

Service of Publication

A petition to cancel the registration identified below having been filed, and the notice of such proceedings sent by registered mail to registrant at the last known address having been returned by the Postal Service as undeliverable, notice is hereby given that unless the registrant listed herein, its assigns or legal representatives, shall enter an appearance within thirty days from the date of this publication, the cancellation will be proceeded with as in the case of default.

Progressive Metal Equipment, Inc., Philadelphia, PA, Reg. No. 617,074 for the mark "PROGRESSIVE", Canc. No. 20,119.

Elsinore Shore Associates, Atlantic City, NJ, Reg Nos. 798,929, 798,930 for the mark "ATLANTIS", Canc. No. 20,680.

Blue Buffalo, Inc., San Diego, CA, Reg No. 1,428,861 for the mark "COCONUT'S ON SHELTER ISLAND AND DESIGN", Canc. No. 20,991.

Richard E. Piazza, dba Westland Physics, Madison, WI, Reg No. 1,205,590 or the mark "GOLD RUSH", Canc. No. 21,195.

Brent Chemicals Corporation, Westport, CT, Reg No. 690,008 for the mark "METACLEAN", Canc. No. 21,352.

Contract Research Software Corporation, Sun Valley, ID, Reg No. 1,430,907 for the mark "PROMATE", Canc. No. 21,499.

The R/L Group, Boston, MA, Reg. No. 1,611,381 for the mark "NOVI", Canc. No. 21,659.

Telemart Discount Centers, Inc., Springfield, IL, Reg Nos. 1,484,732, 1,485,655 for the mark "TELEMART DISCOUNT CENTERS, INC.", Canc. No. 21,703.

Health Advantage, Inc., Phoenix, AZ, Reg No. 1,441,553 for the mark "HEALTH ADVANTAGE", Canc. No. 21,803.

Newco Furniture Manufacturing, dba Sugar Hill Craftsman of Lisbon, NH, Reg No. 1,043,565 for the mark "SUGAR HILL FURNITURE AND DESIGN", Canc. No. 21,806.

application without further addressing the merits of the petition. Obviously, intentional delay in seeking the revival of an abandoned application precludes relief under 37 CFR 1.137(a) or (b) (discussed below).

II. PETITION TO WITHDRAW HOLDING OF ABANDONMENT BASED ON FAILURE TO RECEIVE OFFICE ACTION

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of *Delgar* is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. >For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action.< See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid

abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

Two additional procedures are available for reviving an application that has become abandoned due to a failure to reply to an Office Action: (1) a petition under 37 CFR 1.137(a) based upon unavoidable delay; and (2) a petition under 37 CFR 1.137(b) based on unintentional delay.

III. PETITIONS TO REVIVE AN ABANDONED APPLICATION, OR ACCEPT LATE PAYMENT OF ISSUE FEE

37 CFR 1.137 provides for the revival of abandoned applications and lapsed patents for the failure:

- (A) to timely reply to an Office requirement in a provisional application;
- (B) to timely prosecute in a nonprovisional application;
- (C) to timely pay the issue fee for a design application;
- (D) to timely pay the issue fee for a utility or plant application; and
- (E) to timely pay any outstanding balance of the issue fee (lapsed patents).

A petition under 37 CFR 1.137(a) requires:

- (A) the required reply, unless previously filed;
- (B) the petition fee as set forth in 37 CFR 1.17(l);
- (C) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and
- (D) any terminal disclaimer required pursuant to 37 CFR 1.137(c).

A petition under 37 CFR 1.137(b) requires:

- (A) the required reply, unless previously filed;
- (B) the petition fee as set forth in 37 CFR 1.17(m);
- (C) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and
- (D) any terminal disclaimer required pursuant to 37 CFR 1.137(c).

PTO/PTF Form 09 OCT 2001

PTO/SB/29 (10-00)

Approved for use through 10/31/2002. OMB 0651-0032
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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CONTINUED PROSECUTION APPLICATION (CPA) REQUEST TRANSMITTAL

Submit an original, and a duplicate for fee processing

CHECK BOX, if applicable

☐ DUPLICATE

(Only for Continuation or Divisional applications under 37 CFR 1.53(d))

<p>Address to:</p> <p>Assistant Commissioner for Patents Box CPA Washington, DC 20231</p>	Attorney Docket No. of Prior Application	015280342100
	First Named Inventor	Kaslow, David C., et. al.
	Examiner Name	
	Group Art Unit	
	Express Mail Label No.	EL827033106US

This is a request for a ☐ continuation or ☐ divisional application under 37 CFR 1.53(d),

(continued prosecution application (CPA)) of prior application number 09/554,960

filed on May 22, 2000, entitled VACCINES FOR BLOCKING TRANSMISSION OF PLASMODIUM VIVAX.

NOTES

FILING QUALIFICATIONS: The prior application identified above must be a nonprovisional application that is either: (1) complete as defined by 37 CFR 1.51(b), or (2) the national stage of an international application in compliance with 35 U.S.C. 371. Effective May 29, 2000, a CPA may only be filed in a utility or a plant application if the prior nonprovisional application was filed before May 29, 2000. A CPA may be filed in a design application regardless of the filing date of the prior application. See "Request for Continued Examination Practice changes to and Provisional Application Practice," Final Rule, 65 Fed. Reg. 50092 (Aug. 16, 2000); Interim Rule, 65 Fed. Reg. 14865 (Mar. 20, 2000), 1233 Off. Gaz. Pat. Office (Apr. 11, 2000).

C-I-P NOT PERMITTED: A continuation-in-part application cannot be filed as a CPA under 37 CFR 1.53(d), but must be filed under 37 CFR 1.53(b).

EXPRESS ABANDONMENT OF PRIOR APPLICATION: The filing of this CPA is a request to expressly abandon the prior application as of the filing date of the request for a CPA. 37 CFR 1.53(b) must be used to file a continuation, divisional, or continuation-in-part of an application that is not to be abandoned.

ACCESS TO PRIOR APPLICATION: The filing of this CPA will be construed to include a waiver of confidentiality by the applicant under 35 U.S.C. 122 to the extent that any member of the public who is entitled under the provisions of 37 CFR 1.14 to access to, copies of, or information concerning, the prior application may be given similar access to, copies of, or similar information concerning, the other application or applications in the file jacket.

35 U.S.C. 120 STATEMENT: In a CPA, no reference to the prior application is needed in the first sentence of the specification and none should be submitted. If a sentence referencing the prior application is submitted, it will not be entered. A request for a CPA is the specific reference required by 35 U.S.C. 120 and to every application assigned the application number identified in such request, 37 CFR 1.78(a).

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

1. ☐ Enter the unentered amendment previously filed on _____ under 37 CFR 1.116 in the prior nonprovisional application
2. ☐ A preliminary amendment is enclosed.
3. ☐ This application is filed by fewer than all the inventors named in the prior application, 37 CFR 1.53 (d)(4).
 - a. ☐ **DELETE** the following inventor(s) named in the prior nonprovisional application:

 - b. ☐ The inventor(s) to be deleted are set forth on a separate sheet attached hereto.
4. ☐ A new power of attorney or authorization of agent (PTO/SB/81) is enclosed.
5. ☐ Information Disclosure Statement (IDS) is enclosed:
 - a. ☐ PTO-1449
 - b. ☐ Copies of IDS Citations

[Page 1 of 2]

Burden Hour Statement: This form is estimated to take 0.4 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box CPA, Washington, DC 20231.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

CLAIMS	(1) FOR	(2) NUMBER FILED	(3) NUMBER EXTRA	(4) RATE	(5) CALCULATIONS
	TOTAL CLAIMS (37 CFR 1.16(c) or (j))	50-20* =	30	x \$18=	\$540
	INDEPENDENT CLAIMS 37 CFR 1.16(b) or (i))	9-3** =	6	x \$80=	\$480
	MULTIPLE DEPENDENT CLAIMS (if applicable) (37 CFR 1.16(d))			x =	
				BASIC FEE (37 CFR 1.16)	\$710
				Total of above Calculations =	\$1,730.00
	Reduction by 50% for filing by small entity (Note 37 CFR 1.27).				
	* Reissue claims in excess of 20 and over original patent.				
	** Reissue independent claims over original patent.				
	TOTAL =				\$1,730.00

6. ☐ Small entity status: Applicant claims small entity status. See 37 CFR 1.27.
7. The Commissioner is hereby authorized to credit overpayments or charge the following fees to Deposit Account No. 20-1430 :
- a. ☒ Fees required under 37 CFR 1.16.
- b. ☒ Fees required under 37 CFR 1.17.
- c. ☒ Fees required under 37 CFR 1.18.
8. ☐ A check in the amount of \$ _____ is enclosed.
9. ☐ Payment by credit card. Form PTO-2038 is attached.
10. ☐ Applicant requests suspension of action under 37 CFR 1.103(b) for a period of _____ months (not to exceed 3 months) and the fee under 37 CFR 1.17(l) enclosed.
11. ☐ New Attorney Docket Number, if desired
[Prior application Attorney Docket Number will carryover to this CPA unless a new Attorney Docket Number has been provided herein.]
12. a. ☐ Receipt For Facsimile Transmitted CPA (PTO/SB/29A)
- b. ☒ Return Receipt Postcard (Should be specifically itemized, See MPEP 503)
13. ☒ Other: PTO/SB/61 Petition for Revival of an Application for Patent Abandoned Unavoidably Under 37 CFR 1.137(a)

NOTE: The prior application's correspondence address will carry over to this CPA UNLESS a new correspondence address is provided below.

14. NEW CORRESPONDENCE ADDRESS☒ Customer Number or Bar Code Label

Customer No. 20350
(Insert Customer No. or Attach bar code label here)

or ☐ New correspondence address below

Name

Address

City

State

Zip Code

Country

Telephone

Fax

15. SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

Name (Print /Type)

Kevin Bastian

Signature

Registration No. (Attorney/Agent)

34,774

Date

October 8, 2001

Under the Paperwork Reduction Act, no persons are required to respond to a collection of information if it displays a valid OMB control number.

FEE TRANSMITTAL for FY 2001

Patent fees are subject to annual revision.
Express Mail No. EL827033106US

AMOUNT OF PAYMENT (\$) 1840

Complete if Known

Application Number 09/554,960
Filing Date April 12, 1998
First Named Inventor Kaslow, David C.
Examiner Name
Group Art Unit
Attorney Docket No. 015280-342100US

METHOD OF PAYMENT

1. ☒ The Commissioner is hereby authorized to charge indicated fees and credit any over payments to:

Deposit Account Number

20-1430

Deposit Account Name

Townsend and Townsend and Crew LLP

☒ Charge Any Additional Fee Required Under 37 CFR 1.16 and 1.17
☐ Applicant claims small entity status. See 37 CFR 1.27

2. ☐ Payment Enclosed:

☐ Check ☐ Credit card ☐ Money Order ☐ Other

FEE CALCULATION

1. BASIC FILING FEE

Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description	Fee Paid
101	710	201	355	Utility filing fee	710
106	320	206	160	Design filing fee	
107	490	207	245	Plant filing fee	
108	710	208	355	Reissue filing fee	
114	150	214	75	Provisional filing fee	
SUBTOTAL (1)					(\$710)

2. EXTRA CLAIM FEES

Total Claims	50	-20**	=	30	Extra Claims	X	Fee from below \$18	=	Fee Paid \$540
Independent Claims	9	-3**	=	6		X	\$80	=	\$480
Multiple Dependent						X		=	

Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description
103	18	203	9	Claims in excess of 20
102	80	202	40	Independent claims in excess of 3
104	270	204	135	Multiple dependent claim, if not paid
109	80	209	40	** Reissue independent claims over original patent
110	18	210	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$1020)

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description	Fee Paid
105	130	205	65	Surcharge - late filing fee or oath	
127	50	227	25	Surcharge - late provisional filing fee or cover sheet.	
139	130	139	130	Non-English specification	
147	2,520	147	2,520	For filing a request for reexamination	
112	920*	112	920*	Requesting publication of SIR prior to Examiner action	
113	1,840*	113	1,840*	Requesting publication of SIR after Examiner action	
115	110	215	55	Extension for reply within first month	
116	390	216	195	Extension for reply within second month	
117	890	217	445	Extension for reply within third month	
118	1,390	218	695	Extension for reply within fourth month	
128	1,890	228	945	Extension for reply within fifth month	
119	310	219	155	Notice of Appeal	
120	310	220	155	Filing a brief in support of an appeal	
121	270	221	135	Request for oral hearing	
138	1,510	138	1,510	Petition to institute a public use proceeding	
140	110	240	55	Petition to revive - unavoidable	110
141	1,240	241	620	Petition to revive - unintentional	
142	1,240	242	620	Utility issue fee (or reissue)	
143	440	243	220	Design issue fee	
144	600	244	300	Plant issue fee	
122	130	122	130	Petitions to the Commissioner	
123	50	123	50	Petitions related to provisional applications	
126	180	126	180	Submission of Information Disclosure Stmt	
581	40	581	40	Recording each patent assignment per property (times number of properties)	
146	710	246	355	Filing a submission after final rejection (37 CFR § 1.129(a))	
149	710	249	355	For each additional invention to be examined (37 CFR § 1.129(b))	
179	710	279	355	Request for Continued Examination (RCE)	
169	900	169	900	Request for expedited examination of a design application	

Other fee (specify)

The Commissioner is authorized to charge any additional fees to the above noted Deposit Account.

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$110)

SUBMITTED BY

Complete (if applicable)

Name (Print/Type) Kevin Bastian Registration No. (Attorney/Agent) 34,774 Telephone 415-576-0200
Signature Date October 8, 2001

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APPLICATION NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/554960	KASLOW	D 15280-3421PC
INTERNATIONAL APPLICATION NO.		

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PCT/US98/25742

I.A. FILING DATE	PRIORITY DATE
12 APR 98	12 MAY 97

DATE MAILED:

01 JUN 2001

NOTIFICATION OF ABANDONMENT

The United States Patent and Trademark Office in its capacity as

☐ a Designated Office (37 CFR 1.494), ☒ an Elected Office (37 CFR 1.495), has made the following determination:

- ☐ Applicant's letter of express abandonment received _____ is in compliance with CFR 1.138 and is hereby acknowledged.
- ☐ Applicant has failed to provide the full U.S. Basic National Fee by ☐ 20 months (37 CFR 1.494(b)(2)), ☐ 30 months (37 CFR 1.495(b)(2)).
- ☒ Applicant has failed to respond to the notification of MISSING REQUIREMENTS (Form PCT/DO/EO/905), mailed 23 JUN 00 within the time period set therein.
- ☐ Applicant has failed to properly respond to the notification of MISSING REQUIREMENTS (Form PCT/DO/EO/905), mailed _____ within the time period set therein. See the attached NOTIFICATION OF DEFECTIVE RESPONSE (Form PCT/DO/EO/916).
- ☐ Other.

Therefore, the above identified application failed to meet the requirements of 35 U.S.C 371 and 37 CFR ☐ 1.494, ☒ 1.495 and is ABANDONED AS TO THE UNITED STATES OF AMERICA.

Vonda M. Wallace 

Telephone: 703-305-3736

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